

REMARKS/ARGUMENTS

Applicants have studied the Final Office Action dated April 29, 2009 and have made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1, 3-17, and 19-27 are pending. Claims 1, 5, and 19-24 are amended. Claims 2 and 18 are cancelled. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner:

- (1-2) rejected claims 1-8, 10-12, and 16 under 35 U.S.C. § 102(b) as being anticipated by K. Landsberger (U.S. Patent No. 3,749,369);
- (3-5) rejected claims 9, 13-14, and 17-23 under 35 U.S.C. § 103(a) as being unpatentable over K. Landsberger (U.S. Patent No. 3,749,369); and
- (6) indicated that claims 15 and 24-27 would be allowable if rewritten to overcome the rejections(s) under 35 U.S.C. § 112.

(6) Allowable Subject Matter

The Applicants wish to thank Examiner Kingan for indicating the allowable subject matter of claims 15 and 24-27. Although the Applicants respectfully disagree with the Examiner's rejection of independent claim 18, the Applicants have elected to amend claim 24 solely for the purpose of expediting the patent application process in a manner consistent with PTO's Patent Business Goals (PBG), 65 Fed. Reg. 54603 (September 8, 2000). Specifically claim 24 has been rewritten in independent form including all the limitations of claim 18. The Applicants submit that claim 24 is now in a condition of allowance, which allowance is respectfully requested. Further claims 19-20 and 22-23 have been amended to now depend from newly amended independent claim 24. Claims 25-27 remain dependent on claim 24. Since dependent claims contain all the limitations of the independent claims, claims 19-23 and 25-27 should be allowable as well, which allowance is respectfully requested.

Because the Applicants have now amended independent claim 1, the Applicants have

elected not to rewrite claim 15 in independent form. The Applicants submit that, as argued below, claim 15 is in a condition of allowance, which allowance is respectfully requested.

(1-2) Rejection under 35 U.S.C. §102(b)

As noted above, the Examiner rejected claims 1-8, 10-12, and 16 under 35 U.S.C. § 102(b) as being anticipated by K. Landsberger (U.S. Patent No. 3,749,369).

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Amended independent claim 1 recites, *inter alia*:

wherein the receiving portion defines **at least one hole sized to hold the at least one receiving element** and serve as a collecting vessel for collecting a biological specimen recovered using laser microdissection from biological material to be disposed in the container and wherein the holding portion and the receiving portion are coupled in a contactless manner in such a way that the receiving portion is held in the container via the holding portion and **the at least one hole of the receiving portion with the at least one receiving element may be positioned at multiple locations within the container by moving the holding portion.** (emphasis added)

Newly-amended independent claim 1 now clearly states that the receiving portion of the holding device has a hole for inserting a collecting vessel, which is provided for collecting a biological specimen recovered using laser micro dissection from biological material to be disposed in a container. The holding portion holds the receiving portion within the container such that the hole for the collecting vessel may be positioned at multiple locations within the container by moving the holding portion.

Support for the amendment can be found in, for instance, cancelled claim 2, as well as FIGs. 2 & 3 in connection with page 10, first paragraph of the specification. No new matter has been added.

Newly-amended independent claim 1 differs from Landsberger in a several aspects, namely:

- a) Landsberger does not disclose a holding portion that is capable of holding the receiving portion. In Landsberger, the rotatably mounted magnetic bar 18 can only rotate the housing 22 within the container 16, but it cannot hold the housing 22 within the container.
- b) Landsberger also fails to disclose any receiving portion with a hole for inserting a collecting vessel so that the collecting vessel, which is provided for collecting a biological object as a result of a laser micro dissection process, is held in the opening of the receiving portion. Landsberger only discloses the housing 22 with a cavity 30 defining a measuring chamber 27. The measuring chamber 27 is provided for mixing additives with a liquid in the container 16. It is self evident that this cavity 30 does not allow the holding of a collective vessel within the container, and especially this cavity 30 does not have any hole for inserting a collecting vessel so that the collecting vessel is held in the hole.
- c) Landsberger also fails to disclose any collecting vessel provided for collecting a biological specimen recovered using laser micro dissection from biological material to be disposed in the container. Landsberger does not deal with laser micro dissection technology at all, and Landsberger fails to disclose any collecting vessel for collecting a biological specimen.
- d) Finally, the apparatus of Landsberger does also not employ a contactless coupling between the holding portion and the receiving portion such that the hole for the collecting vessel can be positioned at multiple locations within the container by moving the holding portion. As already indicated above, in Landsberger, the rotatably mounted magnetic bar 18 does not hold the housing 22 in the container 16. In addition, the housing 22 merely spins at a fixed location within the container 16. Consequently, the cavity of the housing 22 is always located at the fixed central position within the container 16. In contrast thereto, however, according to the present invention, the contactless coupling between the receiving portion and the holding portion of the holding device allows the positioning of the hole for the collecting vessel formed in the receiving portion at a plurality of different locations within the container by moving the holding portion.

The Examiner cites 35 U.S.C. § 102(b) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims.¹ Because the elements in independent claim 1 of the instant application are not taught or disclosed by Landsberger, the apparatus of Landsberger does not anticipate the present invention. Dependent claims 3-8, 10-12, and 16 are believed to be patentable as well because they all are ultimately dependent claim 1. Accordingly, the present invention distinguishes over Landsberger for at least this reason. The Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 102(b) has been overcome.

(3-5) Rejection under 35 U.S.C. §103(a)

As noted above, the Examiner rejected claims 9, 13-14, and 17-23 under 35 U.S.C. § 103(a) as being unpatentable over K. Landsberger (U.S. Patent No. 3,749,369).

In the section entitled "(1-2) Rejection under 35 U.S.C. § 102(b)" above, the deficiencies of the prior-art system disclosed in the Landsberger reference were discussed. Claims 9, 13-14, and 17 depend directly from newly amended claim 1. Independent claim 1 distinguishes over Landsberger. Since dependent claims contain all the limitations of the independent claims, claims 9, 13-14, and 17 distinguish over Landsberger, as well.

Accordingly, the Applicants respectfully submit that it is not necessary at this stage to address the Landsberger reference as applied to claims 9, 13-14, and 17. Nor is it necessary to address whether or not there is sufficient suggestion or motivation with a reasonable expectation of success for modifying the Landsberger reference, as required by MPEP § 2143. As such, Applicants respectfully request that the Examiner's

¹ See MPEP §2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.")(emphasis added); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) ("The identical invention must be shown in as complete detail as is contained in the ... claim.").

rejection of claims 9, 13-14, and 17 be withdrawn.

CONCLUSION

In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

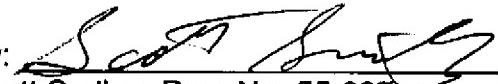
Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

Petition for extension is herewith made. The extension fee for response within a period of 1 month pursuant to Section 1.136(a) in the amount of \$130.00 in accordance with Section 1.17 is enclosed herewith.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

Date: August 24, 2009

By: 
Scott Smiley, Reg. No. 55,627
Attorney for Applicants

Mayback & Hoffman, P.A.
5722 S. Flamingo Rd.
Suite 232
Fort Lauderdale, FL 33330
Tel (954) 704-1599
Fax (954) 704-1588